

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/734,694 Confirmation No.: 6528
Filed : December 13, 2000
Applicant : Ravi Ganesan
Title: : Dynamic Biller List Generation
TC/AU : 3694
Examiner : Ella Colbert
Atty Docket No. : 23952-0138
Customer No. : 72386

COMMENTS ON EXAMINER'S STATEMENT OF REASONS FOR ALLOWANCE**VIA EFS-WEB**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

Responsive to the Notice of Allowability mailed on May 17, 2010, and the Examiner's Statement of Reasons for Allowance, Applicants submit the following clarifying remarks.

With respect to the Examiner's Amendment listed in the Notice of Allowability, dependent Claim 119 is indicated to be a new claim. However, dependent Claim 119 was added by the Applicants in the Response to Final Office Action filed on April 9, 2010.

Additionally, the Examiner's Statement of Reasons for Allowance (hereinafter the "Examiner's Statement") states that the prior art of record, including Chang, et al. (U.S. Pat. No. 5,884,288), Ensel, et al. (U.S. Pat. No. 6,493,685), and Thomas, et al. (U.S. Pat. No. 6,173,272), discloses certain elements of the allowed independent claims. These elements include "receiving ... a request that is not associated with electronic bill presentment, the request comprising information identifying a payee of the payor, wherein the payor has not previously activated electronic bill presentment for the payee" and "accessing ... based on at least a portion of the received information, a bill presentment information associated with the payee." First, it should

be noted that the Examiner's Statement does not accurately recite the elements of the allowed independent claims. The recitations set forth above are accurate recitations included in certain allowed independent claims. Second, the Applicants do not acquiesce to the purported teachings of the art references cited by the Examiner's Statement. Applicants would like to point out that distinctions between the claimed inventions and these art references were set forth at least in the Office Action Responses filed on December 11, 2009 and August 26, 2009.

Further, the Examiner's Statement argues that the cited art references do not disclose "storing an indication of the identified payee in a payee pick list comprising one or more payees identified by the payor" and "transmitting ... a presentation of the payee pick list, wherein the presentation includes the generated notification of the bill presentment information." Again, it should be noted that the Examiner's Statement does not accurately recite the recitations included in certain allowed independent claims. Additionally, although the recitations set forth in the Examiner's Statement are included in allowed independent Claims 120 and 121, these recitations are not included in allowed independent Claims 60, 79, and 99. Further, it is respectfully asserted that allowed independent Claims 120 and 121 recite a combination of elements that are allowable for reasons other than those emphasized in the Examiner's Statement.

The Examiner's Statement goes on to state that the cited art references do not disclose "receiving a request ... comprising one of a payment request or a request to add a payee to a pick list associated with the payor." As with other recitations set forth in the Examiner's Statement, the language of the allowed independent claims is not accurately reflected. Additionally, it should be noted that this recitation appears in allowed independent Claims 60, 79, and 99, but not in allowed independent Claims 120 and 121. It is respectfully asserted that independent Claims 60, 79, and 99 and independent Claims 120 and 121 are independently allowable over the art of record. Further, it is respectfully asserted that allowed independent Claims 60, 79, and 99 recite a combination of elements that are allowable for reasons other than those emphasized in the Examiner's Statement.

Moreover, the Examiner's Statement emphasizes certain claim elements as not being disclosed in the prior art. However, such statements should not be construed as identifying the only possible novel and non-obvious features of the Applicants' inventions. The Applicants

Comments on Reasons for Allowance
Applicant: Ravi Ganesan
Filed: December 13, 2000
Application No.: 09/734,694

respectfully assert that the allowed claims may be considered novel and non-obvious over the cited prior art references for reasons other than those emphasized in the Examiner's Statement. Further, the Applicants respectfully assert that the allowed claims are patentable over all art of record and not just those art references emphasized by the Examiner's Statement.

Further, while the Applicants believe that the claims are allowable, the Applicants do not acquiesce that patentability resides in each feature, exactly as expressed in the claims, nor that each feature is required for patentability.

Respectfully submitted,



Rhett S. White
Attorney for Applicant
Registration No. 59,158

Date: July 21, 2010

SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996
404.853.8037
404.853.8806 (fax)
Atty. Docket No.: 23952-0138